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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,616	02/10/2004	Howard Jason Harrison	81328.0003	3389

29693 7590 10/20/2004
WILEY, REIN & FIELDING, LLP
ATTN: PATENT ADMINISTRATION
1776 K. STREET N.W.
WASHINGTON, DC 20006

EXAMINER

LE, TAN

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,616

Applicant(s)

HARRISON ET AL

Examiner

Tan Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 9-11 and 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-8 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the second office action for serial number 10/774,616. This application contains 17 pending claims numbered 1-17. Claims 3-5, 9-11 and 13-17 have been withdrawn.

2. An affirmation of the election has been made by applicant in replying to the previous office action. Applicants transverse on the ground that examiner has not shown that a serious burden exists in examining all the claims together and request withdrawal of the requirement for restriction and examination of all the pending claims. This is not found persuasive because: a) the transverse apparently overlooks the fact that Applicant's claims recited mutually exclusive characteristics. For example, claims 1 and 7 recite features that under the disclosure are found in the species of Figs. 1, 9 and 10; but not in other species, meanwhile claims 3-5 or 9-11 recite features, which under the disclosure are found in other species such the species of Figs. 7-8 but not in the species of Figs. 1,9 and 10. The mutual exclusive characteristics recited in Applicants' claims show that a through search for the subject matter of any one group of claims would not encompass a search for the subject matter with the remaining claims. Thus the recited mutually exclusive characteristics would render undue burden for the examiner to search all the groups of species together.

The requirement is still deemed proper and is therefore made FINAL.

3. This application contains claims 3-5, 9-11 and 13-17 drawn to an invention nonelected with traverse in the amendment filed 9/30/04. A complete reply to the final

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rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

4. Applicants' clarification of independent claims 1 and 7 are not a doll figure in combination with any particular eyeglasses is acknowledged.

5. Amendment to drawings with replacement all sheets is approved.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 6, 7-8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,309,016 to Aloisi.

Aloisi discloses all the subject matter of claims 1-2, 6, 7-8 and 12 as evidently shown in Figs. 1-6 or 8 for example wherein the arm together with the body form a holding device and capable of receiving the pair of eyeglasses.

Response to Arguments

7. Applicant's arguments filed 9/30/04 have been fully considered but they are not persuasive.

Applicants' argument with respect to Aliosi as presented on page 10 of the Remarks has been considered but is not persuasive.

Particularly, Applicants' argument that the size and shape of the "object holder" in Aloisi are clearly not capable of being positioned so that each "arm" can contact a pair

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of eyeglass. Examiner respectfully asserts that the device of Aloisi is clearly capable of being positioned so that each "arm" can be adapted to contact a pair of eyeglass if so desired since a) Applicants have not provided any criticalities or specifically pointed out that size ratio or length ratio with respect to the eyeglass or any particular eyeglass.

Thus one skilled in the art would have expected any size of the doll figure or the size of the eyeglass, and the "arm" of the Aloisi could support and contact the eyeglass at a certain size if so desired by one skilled in the art; b) the eyeglass as argued is only for the intended use of the claimed invention. "A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Also " A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus if the prior art teaches all the structural limitations of the claims. Ex parte Masham, 2 USPQ. 2d 1647 (BPAI 1987). In this case examiner respectfully asserts that Aloisi clearly teaches all the structural limitations of claims 1-2, 6-8 and 12 and clearly capable of support the eyeglass. Accordingly, the rejection as being anticipated by Aloisi is therefore, maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244. The examiner can normally be reached on Mon.-Fri. from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
October 8, 2004



LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER